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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLARK BENDALL, TOM BRITTON, EDWARD B. HUBBEN,
THOMAS W. KARPEN, THOMAS ELDRED LAMBDIN, RAYMOND A.
LIA, JON SALVATI, JOSHUA SCOTT, KEN VON FELTEN, TODD
ABERNETHY, and SCOTT OSIECKI

Appeal 2009-007379
Application 10/768,761¹
Technology Center 3700

Before JEAN R. HOMERE, ST. JOHN COURTENAY III, and MICHAEL
R. ZECHER, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed on January 29, 2004. This application claims priority to the following provisional applications: 1) 60/443,521, filed on January 29, 2003; and 2) 60/520,996, filed on November 18, 2003. The real party in interest is GE Inspection Tech., LP. (App. Br. 3.)

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's final rejection of claims 10-14 and 17-34. (App. Br. 5.) Claims 1-9, 15, 16, and 35-40 have been withdrawn from consideration. (*Id.*) We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We reverse and enter a new ground of rejection.

Appellants' Invention

Appellants invented a remote video inspection system that utilizes modular units, including a computation module, and is capable of communicating with a central computer workstation. (Spec. 1, ¶ [0002].)

Illustrative Claim

Independent claim 10 further illustrates the invention as follows:

10. A modular visual inspection system for viewing the interior of a structure, comprising:

a base unit element comprising a memory element, a processor element, and a light source;

a unitary control and display handset element comprising a screen element for viewing the interior of the structure and an articulation control element;

a plurality of insertion elements for imaging the interior of the structure, each of said plurality of said insertion elements comprising an imaging sensor and an elongated braided portion,

wherein said plurality of insertion elements include at least two insertion elements have different physical or optical characteristics,

wherein the base unit element is in electro-optical communication with the unitary control and display handset element,

wherein each one of said plurality of insertion elements can be connected to said unitary control and display handset element, and

wherein each one of said plurality of insertion elements can be used without modification of said unitary control and display handset element.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Chikama et al.	US 5,002,041	Mar. 26, 1991
Pearlman	US 5,347,992	Sep. 20, 1994
Saito et al.	US 6,184,922 B1	Feb. 6, 2001
Murata et al.	US 2001/0051762 A1	Dec. 13, 2001
Hill	US 6,929,600 B2	Aug. 16, 2005 (filed Jul. 23, 2002)

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

Claims 10, 12-14, 17, 19-21, 23-28, 30, 33, and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Murata, Hill, and Chikama.

Claim 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Murata, Hill, Chikama, and Pearlman.

Claims 18, 22, 29, 31, and 32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Murata, Hill, Chikama, and Saito.

Appellants' Contentions

Although Appellants agree with the Examiner's claim construction of the term "unitary" (i.e., any group of things regarded as an entity), Appellants allege that the Examiner unreasonably construes the claimed "handset element" as any element that is capable of manipulation by hand. (Reply Br. 6-7, 12-14.) Appellants contend that the claimed "handset element" should be broadly, but reasonably construed as a distinct element that includes a screen element and a control element, both of which are contained within a unitary housing that is capable of manipulation by hand. (*Id.* at 7-11.) Therefore, based on the preceding claim construction, Appellants argue that Murata's endoscope system, which includes a remote control that is separate and distinct from a display device, does not teach or fairly suggest "a unitary control and display handset element," as recited in independent claim 10. (*Id.* at 12-13.)

Examiner's Findings and Conclusions

The Examiner concludes that a "handset element" can be broadly, but reasonably construed as any element that is capable of manipulation by hand. (Ans. 13-14.) Therefore, the Examiner finds that since Murata's display device and remote control unit are both contained within the endoscope system, and both capable of manipulation by hand, Murata teaches or fairly suggests the disputed limitation. (*Id.*)

II. ISSUE

The pivotal issue before us is whether Appellants have shown that the Examiner erred in concluding that the combination of Murata, Hill, and

Chikama renders independent claim 10 unpatentable? In particular, the issue turns on whether the proffered combination teaches or fairly suggests “a unitary control and display handset element comprising a screen element for viewing the interior of the structure and an articulation control element,” as recited in independent claim 10.

III. FINDINGS OF FACT

The following Findings of Fact (hereinafter “FF”) are shown by a preponderance of the evidence.

Murata

FF 1. Murata’s figure 1 discloses a drum-inclusive endoscope system (1) that consists of “an endoscope 3 for industrial use, a cylindrical drum 4, a box-like main unit 5, a front panel 6, a remote control 8, a display device 10, a stowage lid 11, and a battery 13.” (2: ¶ [0045].) Murata discloses connecting the remote controller unit (8) to the main unit via the front panel (6) over a cable (7). (*Id.*) Murata also discloses that the display device (10) is a liquid crystal monitor, which is located at the tip end of a stretchable and contractile monopode or column (9), such that the display device (10) is capable of swiveling freely. (*Id.*)

FF 2. Murata’s figure 2 depicts that the remote control unit (8) contains a plurality of control mode selection switches (82) and an angling lever (83) connected to a remote control central processing unit (hereinafter “CPU”) (81). (3-4: ¶ [0062].)

Hill

FF 3. Hill's figure 3c depicts a connector (136) that slides up and down a stylet (104) in order to connect a variety of endotracheal tubes having various lengths to the universal adaptor (140). (Col. 10, ll. 17-19.)

IV. ANALYSIS

Claim 10

Independent claim 10 recites, *inter alia*, "a unitary control and display handset element comprising a screen element for viewing the interior of the structure and an articulation control element."

We begin our analysis by first considering the scope and meaning of the claimed term "unitary control and display handset element," which must be given the broadest reasonable interpretation consistent with Appellants' disclosure, as explained in *In re Morris*, 127 F.3d 1048 (Fed. Cir. 1997):

[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

Id. at 1054. *See also* *Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (stating that "claims must be interpreted as broadly as their terms reasonably allow.")

Appellants' Specification states that:

The handset combines the display and control features that are necessary and useful for a user of the remote video inspection system 100 to monitor and control the operation of the remote video inspection system 100 and to observe, evaluate and record the results of the inspection. The handset also provides electrical, optical, mechanical and fluid communication as necessary between the various cables and replaceable

probes...that are used in the operation of the remote video inspection system 100.

(Spec. 15, ¶ [0065].)

Further, Appellants' Specification states that "[f]ig. 22 illustrates...a cross-sectional drawing of the handset 550," (*id* at 33, ¶ [0107]) and "[f]ig. 26...illustrates features of the handset according to principles of the invention." (*Id* at 35, ¶ [0114].)

Our reviewing court states, "the 'ordinary meaning' of a claim term is its meaning to the ordinary artisan after reading the entire patent." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005).

Upon reviewing Appellants' Specification for context, and in accordance with the plain meaning of a handset, we conclude that the claimed term "unitary control and display handset element" can be broadly, but reasonably construed as a handheld device that includes both a display and controller, which allows a prospective user to monitor and control the operation of a remote video inspection system by hand.

Consistent with our claim construction above, we conclude that the Examiner's reading of the claimed "unitary control and display handset element" on Murata's endoscope system, which includes a remote control that is separate and distinct from a display device (FF1), to be overly broad and unreasonable. While Murata's endoscope system includes a remote control and a display device that are both capable of manipulation by hand, they are not embodied together in a handheld device that allows a prospective user to monitor and control the operation of the endoscope system by hand. Rather, the remote control and display device are separate devices that are indirectly connected via the box-like unit. (*Id.*) Further, we

find that while Murata's endoscope system can be considered as a unitary device that includes a remote control and display device, it does not teach or fairly suggest the disputed limitation because the endoscope system is not a handheld device. Thus, we find that the Examiner improperly relied upon Murata's disclosure to teach or fairly suggest the disputed limitation. Further, we find that neither Hill nor Chikama remedy the deficiencies in the Examiner's rejection.

Since Appellants have shown at least one error in the rejection of independent claim 10, we need not reach the merits of Appellants' other arguments. It follows that Appellants have shown that the Examiner erred in concluding that the combination of Murata, Hill, and Chikama renders independent claim 10 unpatentable.

Claims 11-14 and 17-34

Since dependent claims 11-14 and 17-34 also incorporate the limitation discussed above, we find that Appellants have also shown error in the Examiner's rejection of these claims for the reasons set forth in our discussion of independent claim 10.

V. NEW GROUND OF REJECTION

We enter the following new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

35 U.S.C. § 103(a) Rejection—Combination of Murata, Hill, and Chikama

Claim 10

Independent claim 10 recites, *inter alia*:

[1]) a unitary control and display handset element comprising a screen element for viewing the interior of the structure and an articulation control element; [and]...[2]) wherein each one of said plurality of insertion elements can be connected to said unitary control and display handset element.

We begin by noting that we adopt as our own the Examiner's findings pertaining the undisputed limitations of independent claim 10. In regards to the disputed limitations of independent claim 10, Murata discloses that the remote control includes a plurality of control mode selection switches, an angling lever, and a CPU. (FF 2.) We find that an ordinarily skilled artisan would have readily appreciated incorporating Murata's display device into the remote control, thereby creating a unitary handheld device that includes both a display and a plurality of control switches, which allow a prospective user to monitor and control the operation of a remote video inspection system by hand. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007) ("[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result."). Thus, we find that Murata teaches or fairly suggests "a unitary control and display handset element comprising a screen element for viewing the interior of the structure and an articulation control element," as recited in independent claim 10.

Additionally, Murata discloses that the endoscope is indirectly connected to both the display device and the remote control via the front panel of the box-like main unit. (FF 1.) Therefore, since independent claim 10 does not preclude an indirect connection, we find that an ordinarily skilled artisan would have readily appreciated indirectly connecting

Murata's endoscope to the remote control/display configuration set forth above. Moreover, Hill discloses numerous endotracheal tubes that have various lengths. (FF 3.) We find that an ordinarily skilled artisan would have appreciated that Murata's remote control/display configuration is also capable of indirectly connecting to each one of Hill's endotracheal tubes, thereby providing a prospective user (i.e., doctor) with greater flexibility in selecting the appropriate endotracheal tube when inspecting a patient's trachea. *KSR*, 550 U.S. at 417 (“[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”). Thus, we find that the combination of Murata and Hill teaches or fairly suggests “wherein each one of said plurality of insertion elements can be connected to said unitary control and display handset element,” as recited in independent claim 10. Accordingly, we find that the combination of Murata, Hill, and Chikama renders the subject matter of independent claim 10 unpatentable.

VI. OTHER ISSUES

The Board of Patent Appeals and Interferences is a review body rather than a place of initial examination. We have made the rejection regarding independent claim 10 under 37 C.F.R. § 41.50(b). However, we have not reviewed the remaining claims 11-14 and 17-34 to the extent necessary to determine whether these claims are unpatentable over Murata, Hill, Chikama, and/or other prior art. We leave it to the Examiner to determine the appropriateness of any further rejections based on these or other references. Our decision not to enter a new ground of rejection for all claims

should not be considered as an indication regarding the appropriateness of further rejection or allowance of the non-rejected claims.

VII. CONCLUSIONS OF LAW

1. Appellants have shown that the Examiner erred in rejecting claims 10-14 and 17-34 as being unpatentable under 35 U.S.C. § 103(a).
2. We have entered a new ground of rejection against claim 10 as being unpatentable under 35 U.S.C. § 103(a).

VIII. DECISION

1. We reverse the Examiner's decision to reject claims 10-14 and 17-34 as being unpatentable under 35 U.S.C. § 103(a).
2. We reject claim 10 as being unpatentable under 35 U.S.C. § 103(a).

37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

- (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
- (2) *Request rehearing*. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record. . . .

REVERSED
37 C.F.R. § 41.50(b)

msc